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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,173	07/02/2001	Satoshi Hoshino	OSP-10752	9512
7590	07/30/2004		EXAMINER	
McGinn & Gibb, PLLC Suite 200 8321 Old Courthouse Road Vienna, VA 22182-3817			PATEL, SHEFALI D	
			ART UNIT	PAPER NUMBER
			2621	
			DATE MAILED: 07/30/2004	

5

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/895,173	HOSHINO, SATOSHI
	<b>Examiner</b>	<b>Art Unit</b>
	Shefali D Patel	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2, 4</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al (JP 06-068339) (hereinafter, “Sato”).

**PLEASE NOTE:** This is a computer translation of the Japanese reference 06-068339.

English translation of this reference can be provided upon applicant's request.

With regard to **claim 1** Sato discloses an electronic journal preparation system (pages 1-2 paragraph 0010, See the abstract) comprising: a face image pick-up portion for picking up a face image of a customer by a fixed camera (page 2 paragraph 0015 lines 2-3); a card embossed image pick-up portion for picking up a card embossed image from a bank card when said customer inputs said bank card (page 2 paragraph 0015 lines 18-20; page 3 paragraph 0017 lines 4-7, paragraph 0023 lines 7-9); a customer transaction data image processing portion for forming an image regarding customer transaction data (page 3 paragraph 0016 lines 4-7); a journal data synthesizing portion for synthesizing a journal data by assembling said face image picked up by said face image pick-up portion, said card embossed image picked up by said card embossed image pick-up portion, and said customer transaction data image picked up by said customer

Art Unit: 2621

transaction data image processing portion (synthesize (i.e., combine) the photo of a face, the embossed data, and the transaction data as disclosed on pages 4-5 paragraph 0034); and a journal data storing portion for storing said journal data synthesized by said journal data synthesizing portion into an electronic recording medium provided in the electronic journal preparation system (storing in storage section 14 as disclosed on page 5 paragraph 0034 lines 6-10).

With regard to **claim 2** Sato discloses journal synthesizing portion adding character data to a header portion of said journal data as seen in Figure 14 and also on page 5 bottom of paragraph 0039 where the contact of dealings are located at the corner monitor when information about the use is displayed.

**Claim 4** recites identical features as claim 1 except claim 4 is a method claim. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 4.

**Claim 5** recites identical features as claim 2 except claim 5 is a method claim. Thus, arguments similar to that presented above for claim 2 is equally applicable to claim 5.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP 06-068339) in view of Hanna et al. (US 6,761,308) (hereinafter, "Hanna").

With regard to **claim 3** Sato discloses all of the claimed subject matter as already discussed above in paragraph 2, claim 1, and the arguments are not repeated herein, but are incorporated by reference. Sato does not expressly disclose inserting a watermark into said customer transaction data. Hanna discloses inserting watermark into customer transaction data at col. 33 lines 44-55. Sato and Hanna are combinable because they are from the same field of endeavor, i.e., keeping track of banking (i.e., financial) transaction by a machine/system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Hanna with Sato. The motivation for doing so is to provide greater assurance of the integrity of the image as suggested by Hanna at col. 33 lines 50-52. Therefore, it would have been obvious to combine Hanna with Sato to obtain the invention as specified in claim 3.

**Claim 6** recites identical features as claim 3 except claim 6 is a method claim. Thus, arguments similar to that presented above for claim 3 is equally applicable to claim 6.

With regard to **claim 7** Sato discloses all aspects of the claimed invention except for using Consumer Transaction Facility (CTF) instead of an Automated Teller Machine (ATM). It would have been obvious to substitute an ATM for the CTF in Sato, since the Examiner takes notice that these two types of Automated Machines are art recognized equivalents in carrying out automatic financial transactions.

With regard to **claims 8 and 9**, claim 7 substantially encompasses the limitation of this claim, and are rejected the same as claim 7. Thus, arguments similar to that presented above for claim 7 is equally applicable to claims 8 and 9.

Art Unit: 2621

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,307,948; US 6,731,778; US 5,422,468.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DANIEL MIRIAM  
PRIMARY EXAMINER

Shefali D Patel  
Examiner  
Art Unit 2621

July 23, 2004